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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,887	02/04/2004	Thor Itt Chiam	FLEX-00300	5368

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EXAMINER

STEIN, JULIE E

ART UNIT PAPER NUMBER

2617

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/772,887	Applicant(s) CHIAM ET AL.	
	Examiner Julie E. Stein, Esq.	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Drawings

2. In view of the amendments to the specification, the drawing objections are withdrawn.

Specification

3. In view of the amendments to the specification, the specification objections are withdrawn.

4. The following prior art rejections are being maintained, but may have been slightly modified in order to further clarify the rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 7-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,463,304 to Smethers.

Smethers discloses all the elements of independent claim 1, including a menu-driven electronic device (Figure 1) comprising:

- a. a display configured to selectively display one of a plurality of menus (Figure 1), including a main menu and a sub-menu (Figure 1 and Figures 3A-C), and
- b. a two-dimensional navigation key (Figure 1, element 112) configured to select one of a plurality of main menu items of the main menu (column 4, lines 19 to 42) and to select a sub-menu item of the sub-menu associated with a selected main menu item (Figure 3B and the corresponding description in column 6 and column 8, lines 10 to 15).

The rejection of claim 1 is hereby incorporated. Smethers also discloses all the elements of independent claim 18, including a menu-driven telecommunications device (Figure 1) comprising:

- a. a display configured to selectively display one of a plurality of menus (Figure 1), including a main menu and a sub-menu (Figure 1 and Figures 3A-C), and
- b. a two-dimensional navigation key (Figure 1, element 112) configured to select one of a plurality of main menu items of the main menu (column 4, lines 19 to 42) and to select a sub-menu item of the sub-menu associated with a selected main menu item (Figure 3B and the corresponding description in column 6 and column 8, lines 10 to 15), wherein the device displays a plurality of sub-menu items (Figure 3B and the corresponding description in column 6).

Smethers also discloses all the elements of dependent claim 2, including wherein at least a portion of the plurality of main menu items is displayed (Figure 1), and further wherein both the main menu and the sub-menu can be accessed by maintaining contact

with the two-dimensional key. See column 6, lines 30 to 42 and column 8, lines 6 to 34, which indicate that the navigation keys may be used multiple times as selection keys, therefore it would be inherent that a user could navigate through the menus by maintaining contact with the navigation keys.

Smethers also discloses all the elements of dependent claim 3, including wherein the device is configured to allow navigation through the plurality of menus by using the two-dimensional navigation key. *Id.*

Smethers also discloses all the elements of dependent claim 4, including wherein the device is configured to allow navigation through the plurality of menus while maintaining tactile contact with the two-dimensional navigation key. See claim 2.

Smethers also discloses all the elements of dependent claim 5, including wherein the device is configured to allow toggling among the at least two control levels by a single access of the two-dimensional navigation key. See, column 4, lines 14 to 41.

Smethers also discloses all the elements of dependent claim 7, including wherein the device is configured to allow scrolling among at least two control levels by a single access of the two-dimensional navigation key. See Figures 1 and 3B and their corresponding descriptions.

Smethers also discloses all the elements of dependent claim 8, including wherein the device is configured to display the selected main menu item simultaneously with the sub-menu associated with the selected main menu item. See Figures 3A-C and their corresponding descriptions.

Smethers also discloses all the elements of dependent claim 9, including wherein the device is configured to display the selected main menu item simultaneously with a plurality of sub-menu items associated with the selected main menu item. See Figure 3B and its corresponding description.

Smethers also discloses all the elements of dependent claim 10, including wherein the plurality of menus are organized in a menu tree. See Figures 3A-C and their corresponding descriptions.

Smethers also discloses all the elements of dependent claim 11, including wherein the main menu further comprises a main menu item icon representing a main menu item. See Figure 1 and its corresponding description.

Smethers also discloses all the elements of dependent claim 12, including wherein the device is configured to display the main menu item icon to provide a visual reference to an item in the menu tree of the menu being displayed. See Figures 3A-C and their corresponding descriptions.

Smethers also discloses all the elements of dependent claim 13, including wherein when the device displays at least a portion of the main menu, the main menu item icon is displayed in a first appearance, and when the device displays the sub-menu, the main menu item icon is displayed in a second appearance different from the first appearance. See Figures 1 and 3A-C and their corresponding descriptions.

Smethers also discloses all the elements of dependent claim 14, including wherein the first appearance differs from the second appearance by at least one of size, shape, color, highlighting, and pattern. Id.

Smethers also discloses all the elements of dependent claim 15, including wherein when the device displays the sub-menu, the main menu item icon is displayed in a third size different from the first size and the second size. See MPEP 2144, changing the size of an element of the claimed invention does not patentably distinguish the claimed invention.

Smethers also discloses all the elements of dependent claim 16, including wherein the main menu further comprises a non-graphical listing of the plurality of sub-menu items of the sub-menu associated with the selected main menu item. See, Figures 1 and 3B and their corresponding descriptions.

Smethers also discloses all the elements of dependent claim 17, including wherein the device is a phone. See Figure 1 and its corresponding description.

Smethers also discloses all the elements of dependent claim 19, including wherein when the device displays on the display the sub-menu associated to the selected main menu item, a main menu icon is displayed in the sub-menu to provide a visual reference to the selected main menu item in the menu tree of the menu being displayed. See Figures 3A-C and their corresponding descriptions.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 6 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smethers in view of U.S. Patent Application Publication No. 2003/0064757 to Yamadera et al.

The rejections of claims 1 and 18 are hereby incorporated. Smethers teaches all the elements of independent claim 23, including a menu-driven telecommunications device (Figure 1) comprising:

- a. a display configured to selectively display one of a plurality of menus (Figure 1), including a main menu and a first sub-menu (Figure 1 and Figures 3A-C), and

- b. a two-dimensional navigation key (Figure 1, element 112) configured to select one of a plurality of main menu items of the main menu (column 4, lines 19 to 42) and to select a first sub-menu item of the first sub-menu associated with a selected main menu item (Figure 3B and the corresponding description in column 6 and column 8, lines 10 to 15).

However, Smethers does not teach displaying a second sub-menu or that the two-dimensional navigation key is configured to select a second sub-menu item of the second sub-menu associated with the selected main menu item. But, Yamadera does teach a method of displaying and selecting multiple sub-menus on a mobile phone using a navigation key (4) that can move in four directions. See Figures 1, 6A-D and 7A-D and their corresponding descriptions, and paragraph 42.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to understand that Smethers would include additional sub-menus as taught by Yamadera because the additional sub-menus allow a user to select more specific/detailed actions. See e.g. paragraph 70. In addition, one of ordinary skill in the art at the time the invention was made would have understood that the navigation keys taught in Smethers would be capable of selecting the additional sub-menus as Yamadera teaches the concept that a navigation key capable of moving in four directions may be used to select such menus. See paragraphs 76 to 82.

The rejection of independent claim 23 is hereby incorporated. Smethers teaches all the elements of dependent claim 6, except wherein the device is configured to allow toggling between the main menu and one of the plurality of main menu items by using a first direction of the two-dimensional navigation key and to allow toggling between the selected main menu item and the sub-menu associated with the selected main menu item by using a second direction of the two-dimensional navigation key.

Yamadera teaches selecting a menu item using a navigation key moved in one direction (up) and then toggling between the main menu item and the sub-menu by

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using a second direction of a navigation key (right). See paragraph 64. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to use various methods of toggling between main menu items and sub-menus, including the method taught by Yamadera because the method includes more information on the display screen via more icons and the use of specific navigation directions allows a user to move between the main menu item and sub-menus with greater ease. See Yamadera, paragraphs 66 to 70.

The rejection of claim 23 is hereby incorporated. Smethers in view of Yamadera teaches all the elements of dependent claim 20, including wherein the plurality of menus includes a first sub-menu and a second sub-menu (Yamadera, Figures 7A-D), wherein the first sub-menu further comprises a plurality of first sub-menu items (Id.) and further wherein one of the plurality of first sub-menu items is associated to a second sub-menu (Id.).

The rejection of claim 23 is hereby incorporated. Smethers in view of Yamadera teaches all the elements of dependent claim 21, including wherein the second sub-menu further comprises a plurality of second sub-menus items. See Yamadera, Figures 7A-D.

The rejection of claim 23 is hereby incorporated. Smethers in view of Yamadera teaches all the elements of dependent claim 22, including wherein a third orientation of the two-dimensional navigation key is configured to select one of the plurality of second sub-menu items. See Yamadera, Figures 7A-D.

Smethers in view of Yamadera teaches all the elements of dependent claim 24, including wherein the device is configured to allow scrolling between the main menu and one of the plurality of main menu items by using a first direction of the two-dimensional navigation key (Yamadera, paragraphs 76 to 77), to allow scrolling between the selected main menu item and the first sub-menu associated with the selected main menu item by using a second direction of the two-dimensional navigation key (Id.), and further to allow scrolling between the second sub-menu associated with the selected main menu item and a second sub-menu item by using a third direction of the two-dimensional navigation key (Yamadera, paragraphs 78 to 79).

Smethers in view of Yamadera teaches all the elements of dependent claim 25, including wherein the third direction corresponds with the first direction of the two-dimensional navigation key. It would have been obvious to one of ordinary skill in the art at the time the invention was made to understand that the directions used to select the first and third directions could be the same because Yamadera teaches that the first direction may be up and the third direction may be pointed in any of four directions, up, down, right, or left. See Yamadera, paragraph 78.

Smethers in view of Yamadera teaches all the elements of dependent claim 26, including wherein the device is configured to display a main menu item icon to provide a visual reference to an item in a menu tree of the menu being displayed. See Yamadera, Figures 6A-D and 7A-D.

Response to Arguments

10. Applicant's arguments filed March 03, 2006 have been fully considered but they are not persuasive.

11. Applicant first argues that Smethers does not disclose a two-dimensional navigation key configured as claimed. However, as identified by the Examiner, Smethers does teach a two-dimensional navigational key, 112 or 312, shown in Figures 1 and 3B respectively of Smethers, which is composed of four arrows, thus "two-dimensional" and, which selects menus and sub-menus as disclosed in column 6, lines 30 to 42. The description in column 6 is of an embodiment of a browser in which the navigation key is used to first select the browser and then select content channels within the browser. Furthermore, the Examiner submits that column 8, lines 6 to 34 of Smethers discloses how a user would go about mapping the navigation keys so that the user could use them in the manner disclosed by Smethers and also claimed by Applicant.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., selecting a menu or sub-men using the two-dimensional navigation key in one single access of the navigation key) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. Applicant also argues that the combination of Smethers and Yamadera does not teach the claimed invention by arguing the references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As stated in the rejection above, claims 6 and 21-26 are rejected under the combination of Smethers and Yamadera and it is the combination that renders the claims obvious. For example, Yamadera (the secondary reference) is cited in part for the teaching of selecting additional sub-menus using a four-way navigation key in the same field of endeavor as Smethers (the primary reference) and thus it would have been obvious to one of ordinary skill at the time the invention was made to select additional sub-menus using the phone of Smethers because Yamadera taught that the multiple sub-menu architecture was well known and in use by various mobile phone programs as was the use of a four-way navigation key. See the rejection above.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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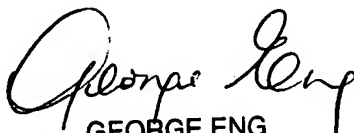
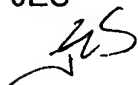
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie E. Stein, Esq. whose telephone number is (571) 272-7897. The examiner can normally be reached on M-F (8:30 am-5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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